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Paper No. 13

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COPY MAILED

JUN 09 2004

In re Application of :
Fazal Raheman :
Application No. 09/542,392 :
Filed: April 4, 2000 :
Attorney's Docket No. 067695.0105 :

OFFICE OF PETITIONS
ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed on May 13, 2004, under 37 CFR 1.137(a) to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or, as described below, under 37 CFR 1.137(b). This is not a final agency decision.

The application became abandoned on December 1, 2002, for failure to file a timely response to the Office action mailed on October 30, 2002, which set a one (1) month shortened statutory period for reply. A Notice of Abandonment was mailed on May 5, 2003.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

- (2) the petition fee as set forth in § 1.17(1);
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

This petition lacks item (3), above.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.¹

In the present petition, petitioner asserts that neither the status of the application nor the nature of the Office action were accessible to him at any time during the due date for reply. Petitioner explains that he was incarcerated from July 9, 2001 to April 16, 2004. Petitioner states that the law firm of Baker and Botts prosecuted the present application since June of 2000. However, due to his incarceration, petitioner states that his oversees company went out of business leaving no contact

¹In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quiqq, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

information for the law firm. In December of 2003, petitioner requested that his friend, Don Mossman, obtain a copy of the entire file from the law firm on his behalf. Petitioner states that on or about May 3, 2004, he received a complete set of paperwork pertaining to the present application from Mr. Mossman. Lastly, petitioner asserts that due to circumstances beyond his control, there was no conceivable way that he could have responded to the nonfinal Office action at any time prior to the filing of the present petition.

The showing of record has been considered, but is not persuasive. Initially, the Office notes that petitioner is ultimately responsible for the prosecution of his application.² Petitioner stated that due to his company going out of business, Baker and Botts had no contact information for petitioner. Petitioner should have attempted to contact the law firm and provide them with a correspondence address so that the firm could communicate with petitioner concerning the prosecution of the application. Additionally, petitioner could have communicated directly with the USPTO requesting the status of his application.

It appears from the petition that petitioner did not have any communication with Baker and Botts since approximately July of 2001. However, petitioner waited until May 13, 2004, to change his correspondence address and revoke power of attorney to Baker and Botts. Petitioner could have filed a change of correspondence address with the USPTO to have his mail forwarded to his prison address at any time during his incarceration. Accordingly, petitioner has not shown that adequate provisions were made for the careful handling of Office actions in order to ensure a timely response thereto. In any renewed petition, petitioner must show what steps were taken during his period of incarceration to communicate with Baker and Botts or the USPTO with regard to his application.

As to petitioner's reliance on Baker and Botts' representation, the Office records indicate that the law firm retained power of attorney until it was revoked by petitioner on May 13, 2004. Unfortunately, the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions.³ Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen

²See In Re Columbo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994).

³Link v. Wabash, 370 U.S. 626, 633-34 (1962).

representative does not constitute unavoidable delay within the meaning of 35 U.S.C. 133 or 37 CFR 1.137(a).⁴

If Baker and Botts was responsible for prosecution of the above-identified application when the reply necessary to avoid abandonment was due, petitioner must include a statement from Baker and Botts as to why action was not taken to prevent the application from becoming abandoned while the application was under the firm's control. Petitioner should send a letter (accompanied by a copy of this decision) to Baker and Botts by registered or certified mail, return receipt requested, indicating to Baker and Botts that the USPTO is requesting its assistance in determining the circumstances surrounding the abandonment of the above-identified application. Such statements should be accompanied by copies of any documents (e.g. correspondence between petitioner and counsel) relevant to the outstanding Office action. In the event that Baker and Botts fails to provide a statement within a period (e.g., within one (1) month) specified in such letter, petitioner should submit a copy of such letter and the return receipt indicating its delivery to the law firm with any renewed petition under 37 CFR 1.137(a).

In summary, while the circumstances surrounding the abandonment of this application and the extended delay in filing the present petition to revive are unfortunate, they do not rise to the level of unavoidable delay. Therefore, the petition is dismissed.

ALTERNATIVE VENUE

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b), which provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, **unless previously filed**. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a

⁴Haines v. Quiqq, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891).

request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Should petitioner decide to file a petition under 37 CFR 1.137(b), the additional petition fee due would be \$665.00 (small entity).

A copy of the form for filing a petition under 37 CFR 1.137(b) to revive an application unintentionally abandoned is enclosed herewith for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the
undersigned at (703) 306-5589.

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Enclosures: Form PTO/SB/64
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